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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,372	09/15/2003	Joerg Beringer	09282.0008-00	1628
22852 7590 01/09/2008 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER MCCORMICK, GABRIELLE A	
			ART UNIT 3629	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/663,372	<b>Applicant(s)</b> BERINGER ET AL.	
	<b>Examiner</b> Gabrielle McCormick	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/9/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

1. This action is in reply to the application filed on September 15, 2003.
2. Claims 1-26 are currently pending and have been examined.

### ***Information Disclosure Statement***

3. The Information Disclosure Statement filed on February 9, 2004 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 25 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed toward an "article bearing medium including machine-readable instructions" (preambles). The specification, in paragraph 0055 on page 18 discusses that the instructions can be received as a "machine-readable signal". A "signal" does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (i.e., process, machine, manufacture, or composition of matter).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-4, 8-9, 12-15, 19-22 and 25-26** are rejected under 35 U.S.C. 102(e) as being anticipated by Howard et al. (US Patent No. 6,697,865 hereafter referred to as "Howard").
8. **Claims 1, 8 and 25:** Howard discloses providing portals that simultaneously "present a single coordinated image to selling partners and customers while providing custom experiences for individual users." (C2; L9-11). Howard discloses "relationship portal software" and "business database" (C2; L35-47: *machine readable instructions*). Howard also discloses an example of context information where a sales person manages the permissions for users, one of which is a lawyer. The sales person can set the lawyer's permissions, but would not have access to the legal content. (C8; L9-13). Thus, the lawyer has access to legal content (and therefore the context information appropriate to a lawyer's permissions). Additionally, Howard discloses:
- *generating a user profile corresponding to a user;* (C4; L35-42)
  - *identifying one or more entities related to the user, said one or more entities having corresponding entity profiles including context information;* (C4; L27-35)
  - *associating at least a portion of the context information from the one or more entity profiles to the user profile;* (C4; L52-55)

- *personalizing a work environment associated with user based on the context information associated with the user profile. (C2; L56-67: a personal relationship portal that has custom appearances and behaviors for each of the employees).*
9. **Claims 14, 19 and 26:** Howard discloses providing portals that simultaneously “present a single coordinated image to selling partners and customers while providing custom experiences for individual users.” (C2; L9-11). Howard discloses “relationship portal software” and “business database” (C2; L35-47: *machine readable instructions*). The relationship between the company (parent) and the user (*child*) is disclosed by Howard in column 4; lines 27-29: “a profile for a company to which a user belongs must exist before a profile for the user can be created.” Howard also discloses an example of context information where a sales person manages the permissions for users, one of which is a lawyer. The sales person can set the lawyer's permissions, but would not have access to the legal content. (C8; L9-13). Thus, the lawyer has access to legal content (and therefore the context information appropriate to a lawyer's permissions). Additionally, Howard discloses:
- *generating a child entity profile corresponding to a child entity; (C4; L35-42)*
  - *identifying a parent entity profile from which the child entity profile depends, the parent entity profile including context information; (C4; L27-35)*
  - *importing at least a portion of the context information from the parent entity profile into the child entity profile, said imported context information comprising inherited context information; (C4; L45-51: the user permissions are limited by the permissions of the company)*
  - *updating the inherited context information in the child entity profile in response to a change in the corresponding at least a portion of the context information in the parent entity profile. (C4; L49-51: when company permissions are removed, all employee permissions are removed. A specific example of a context based permission that is updated is disclosed in C13; L21-34).*

10. **Claims 2 and 20:** Howard discloses explicitly associating context information relating to the user/child entity with the user/child entity profile. (C11; L9-11: the user profile includes preferences and C11; L37-41: the user purposely modifies the user preferences).
11. **Claims 3 and 21:** Howard discloses a configuration function that identifies and creates profiles for companies and employees. The configuration information is kept in a "portal management database 23". (C3; L11-19). Data is gathered from the database by a Java class library. (C3; L48-58). A *context cluster* is understood to be a compilation of data, such as found in database tables, therefore the functionality of the Java class library in gathering data is equivalent to creating a *context cluster*.
12. **Claim 4:** Howard discloses *transporting one or more context clusters into the user profile*. (C4; L45-51: the permissions of a user are limited to the permissions assigned to a company).
13. **Claims 9 and 22:** Howard discloses changing a company profile or modifying a user profile. (C6; L44-47 and C8; L20-37: a change in the company permissions leads to changing (i.e., updating) user permissions).
14. **Claims 12 and 13:** Howard discloses collaborative and business relationships. (C13; L21-34).
15. **Claim 15:** Howard discloses *personalizing a work environment associated with user based on the context information associated with the user profile*. (C2; L56-67: a personal relationship portal that has custom appearances and behaviors for each of the employees).

### ***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.


17. **Claims 5-7, 10-11, 16-18 and 23-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al. (US Patent No. 6,697,865 hereafter referred to as "Howard") in view of Hosea et al. (US Pub. No. 2002/0138331 hereafter referred to as "Hosea").
18. **Claims 5, 6, 7, 16, 17 and 18:** Howard discloses the limitations of claims 1 and 14. Howard does not disclose *links to services and information places*.
19. Hosea, however, discloses a system for personalizing Web pages to meet the interests of Web users based on user profiles. (Abstract). Hosea discloses links to "Yahoo! Shopping" (i.e., a service) and "News & Media" (information places) in Figure 11.
20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included links to services and information, as disclosed by Hosea in the system disclosed by Howard, for the motivation of providing a method of allowing the user to "more quickly and easily locate material that is most likely to be of interest" (Hosea; P[0050]).
21. **Claims 10, 11, 23 and 24:** Howard discloses the limitations of claims 9 and 22. Howard does not disclose determining relevance of context information and removing based on the relevance.
22. Hosea, however, discloses determining the relevance of content to the user based on an affinity rating (P[0047]). The affinity rating is generated by analyzing the user's Web surfing and click-stream data (P[0042]). Content deemed not to be of interest to the user is eliminated (P[0050]).
23. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included eliminating content based on relevance to the user, as disclosed by Hosea, in the system of Howard for the motivation of reducing "what may be perceived by a user as clutter" and simplifying the presentation of the information such that the user can "more quickly and easily locate material that is most likely to be of interest" (Hosea; P[0050]).

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is 571-270-1828. The examiner can normally be reached on Monday - Thursday (6:00- 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Gabrielle McCormick  
Patent Examiner  
Art Unit 3629

  
DENNIS RUHL  
PRIMARY EXAMINER